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PAUL W. MARTIN		EXAMINER		
NCR CORPORATION, LAW DEPT.		CHENCINSKI, SIEGFRIED E		
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GAMEELAH GHAFOOR, AHMAR GHAFOOR,
MARIE MACINTYRE, and ANTHONY HOLMES

Appeal 2009-004947
Application 10/051,355
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-20 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to a method of operating a self-service terminal such as an ATM machine (Spec. 1:1-2). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. An Automated Teller Machine, ATM, comprising:
 - a) a user interface including means for identifying a user;
 - b) means for obtaining contact information which enables the ATM to contact a communications device associated with the user; and
 - c) contact means for establishing a link with the communications device to allow a transaction to be executed using the communications device.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Walker	US 6,327,348 B1	Dec. 4, 2001
Ahuja	US 2001/0056402 A1	Dec. 27, 2001
Smith	US 6,430,496 B1	Aug. 6, 2002
Savage	US 7,194,414 B1	Mar. 20, 2007

The following rejections are before us for review:

1. Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which the applicants regard as the invention.

2. Claims 1, 3-6, 8-12, 14-16, and 18-19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ahuja and Savage.

3. Claims 2 and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, and Official Notice.

4. Claim 7 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, and Official Notice.

5. Claims 17 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, and Walker.

THE ISSUES

With regards to the rejection of claim 12 under 35 U.S.C. § 112, second paragraph the issue turns on whether those skilled in the art would understand what is claimed when the claim is read in light of the Specification.

With regards to the rejection of claim 1 and its dependent claims under 35 U.S.C. § 103(a) the issue turns on whether Savage discloses the elements of claim limitation “b” as asserted by the Examiner. The rejection of the independent claims 5-6, 11-12, and 16 turns on a similar issue.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. The Specification states that a self-service terminal can obtain contact information for a communications device associated with a user and establish a link to allow a transaction to be entered thereby (Spec. 1:18-22).

FF2. Ahuja has disclosed a method and system for accessing financial information or conducting financial transactions using wireless communication devices including cellular phones and personal digital assistants. (Abstract).

FF3. Ahuja in Fig. 7 shows an ATM 150, a wireless financial server terminal 150, an home PC 152, and a telephone network 151 in communication with each other.

FF4. Ahuja at [0044]-[0050] discloses the use of data transfer taking place over the telephone [0044] and that a cellular telephone may serve as a terminal [0050].

FF5. Ahuja at [0044]-[0050] does not disclose the ATM having means for obtaining a telephone number of a telephone associated with the user.

FF6. Savage has disclosed a self-service terminal such as an ATM that includes a speech generator and loudspeaker for producing natural language operating instructions for the user (Abstract).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF7. Savage at Col. 4:15-18 discloses that a user whose account is overdrawn may be advised, in a stern male voice, to immediately contact the relevant financial institution.

FF8. Savage at Col. 4:15-18 does not disclose means for obtaining contact information which enables the ATM to contact a communications device associated with the user.

ANALYSIS

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has determined that the rejection of 12 under 35 U.S.C. § 112, second paragraph, is proper because the phrases describing obtaining contact information which “enables the ATM to contact a communications device” and for establishing a communications link “so that a transaction may be executed (sic)” fail to set forth the subject matter which the applicants regard as their invention (Ans. 3-5, 11-12).

In contrast, the Appellants have argued that this rejection is improper (Corr. App. Br. 20-23).

We agree with the Appellants. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). Here, the cited claim limitations for obtaining contact information which “enables the ATM to contact a communications device” and establishing a communications link “so that a transaction may be executed (sic)” are supported by the

Specification (see FF1) and those skilled in the art would understand what is being claimed in light of the Specification so this rejection is not sustained.

Rejections under 35 U.S.C. § 103

The Appellants argue that the rejection of claim 1 is improper because the prior art which has been cited is missing claim elements and because claim limitations have been ignored (Corr. App. Br. 14-16). The Appellants specifically argue that Savage at Col. 4:15-18 does not show the cited claim recitations (Corr. App. Br. 14).

In contrast, the Examiner has determined that the rejection of record is proper and that the cited claim limitation is shown in the prior art (Ans. 5, 12-13).

We agree with the Appellants. Claim 1 is reproduced below (emphasis added):

1. An Automated Teller Machine, ATM, comprising:
 - a) a user interface including means for identifying a user;
 - b) *means for obtaining contact information which enables the ATM to contact a communications device associated with the user;* and
 - c) contact means for establishing a link with the communications device to allow a transaction to be executed using the communications device.

Here claim limitation “b” requires “means for obtaining contact information which enables the ATM to contact a communications device associated with the user.” The Examiner has asserted that the “means for obtaining contact information” is shown in Savage at Col. 4:15-18 (Ans. 6). Savage at Col. 4:15-18 states that a user whose account is overdrawn may be advised in a stern voice to immediately contact the relevant financial

institution (FF7). Savage at Col. 4:15-18 does not disclose that the user actually contacts the financial institution or even if they do if any “contact information” for them is obtained by the ATM (FF8) as claim limitation “b” requires. For these reasons the rejection of claim 1 and its dependent claims is not sustained. Independent claims 6, 11-12, and 16 contain the same or a similar limitation to the limitation addressed above for claim 1 and the rejection of these claims and their dependent claims is not sustained for these same reasons.

With regards to independent claim 5, the claim includes a limitation for “means for obtaining [a] telephone number for a telephone associated with the user” and claim 10 contains a similar limitation. The Appellants argues that the cited prior art does not show these claim limitations (Corr. App. Br. 39-41). The Examiner has asserted that Ahuja discloses this (Ans. 14-15) and cites to Ahuja at [0044]-[0050]. Ahuja at [0044]-[0050] does disclose the use of data transfer taking place over the telephone (FF4) but does not disclose the ATM having means for obtaining a telephone number of a telephone associated with the user (FF5). For these reasons the rejection of claims 5 and 10 is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 112, second paragraph as failing to set forth the subject matter which the applicants regard as the invention.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 3-6, 8-12, 14-16, 18-19 under 35 U.S.C. § 103(a) as unpatentable over Ahuja and Savage.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 2 and 13 under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, and Official Notice.

We conclude that Appellants have shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, and Official Notice.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 17 and 20 under 35 U.S.C. § 103(a) as unpatentable over Ahuja, Savage, Walker.

DECISION

The Examiner's rejection of claims 1-20 is reversed.

REVERSED

JRG

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